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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,495	04/09/2004	James M. Dennison	24122/1	1412

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/821,495	Applicant(s) DENNISON, JAMES M.	
	Examiner Anthony Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Tecchio et al. 5,456,027.

Tecchio et al. '027 discloses all the limitations of the claims including the following: an athletic shoe with a body portion 20; an upper sole element 120 permanently attached to the body portion; a lower sole element 140 releasably attached to the upper sole element such that a lateral relative motion between the upper sole element and the lower sole element is prevented and longitudinal motion between the upper and lower sole elements is resisted up to a predetermined release force (see Abstract and col. 20, line 16- col. 21, line 48).

3. Claims 2-4, 12, 15-16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ouellette et al. 5,644,857. Ouellette et al. '857 discloses all the limitations of the claims including the following: an athletic shoe comprising a body portion 12; an upper sole element 16 substantially permanently attached to the body portion (see Figure 2); a lower sole element 14 releasably attached to the upper sole element such that lateral relative motion between the upper sole element and the lower sole element is prevented and longitudinal motion between the upper sole element and lower sole element is resisted up to a predetermined release force (note portions 42 and associated portions 44 as well as 28 and associated portions 30, they will translate at a predetermined, i.e. known, force); an upper sole 16 having a bottom surface 21 including a first longitudinal guiding element 42, 30; a lower sole 14 having a top surface 25 including a second longitudinal guiding element 44, 28; the second longitudinal guiding element engaging the first longitudinal guiding element and constraining the upper sole to longitudinal

Art Unit: 3728

motion relative to the lower sole upon exertion of a threshold longitudinal shear force there between (see col. 4, lines 45-64 and col. 5, lines 29-53); the longitudinal guiding elements comprise a rail 44 and slot 42; a ligament portion 36 connected between the upper sole and lower sole and preventing longitudinal translation between the upper sole and lower sole unless a force exceeding a predetermined shear force is exerted there between; an upper sole 16 having a bottom surface 21 including a first longitudinal guiding portion 42; a lower sole 14 having a top surface 25 including a second longitudinal guiding portion 44 adapted for accepting said first longitudinal guiding portion and constraining said upper sole to longitudinal motion relative to the lower sole upon exertion of a threshold longitudinal shear force there between; a shear 36, 24 pin extending between said upper sole and said lower sole; cleats 18 extending downward from said lower sole; means for preventing translation between the upper sole and the bottom sole 36, 24; the shear pins are replaceable (new ones can be added); the longitudinal guiding portions comprise a rail 44 and slot 42.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouellette et al. 5,644,857 as applied to claim 3 above in view of Starks 1,831,268. Ouellette et al. '857 as applied to claim 3 above discloses all the limitations of the claims including the breakaway portion comprising a shear pin 36, 24; the breakaway portion comprising a controlled friction portion (between 44 and 42); the controlled friction portion comprises a plurality of teeth 45 and the shear pin being formed integrally with the lower sole (see Figure 2). Ouellette et al. '857 does not disclose the breakaway portion extending

Art Unit: 3728

through the longitudinal guiding elements. Starks '268 teaches that pins 12 can be placed through apertures 10 in the guiding elements 20, 8 to aid in holding the bottom sole to the top sole for use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place pins, such as those taught by Starks '268, in the guiding rails and slots of Ouellette et al. '857 to aid in holding the two soles together until the breaking force has been met.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied to claim 5 immediately above. The references as applied to claim 5 immediately above disclose all the limitations of the claims except for the breakaway portions being spot welds or adhesive. Spot welds and adhesive are well known art accepted equivalent means for pins used for fastening soles together. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use any known means of fastening sole together, including spot welds, pins, screws, adhesives, to aid in holding the soles of the shoe together during use while still allowing for the breakaway feature to operate at a given minimum applied force.

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouellette et al. 5,644,857 applied to claim 12 above in view of Tecchio et al. 5,456,027. Ouellette et al. '857 as applied to claim 12 above discloses all the limitations of the claims except for the ligament portion being a spring or elastic band. Tecchio et al. '027 teaches that a ligament portion, that portion which attaches one sole to the other, can be attached by a spring loaded mechanism which disengages one sole from the other. The spring in this mechanism meets the limitation of a spring as a ligament portion because it is what aids in connecting the two sole portions together and releasing them. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the ligament portions of Ouellette et al. '857 as applied to claim 12 above out of a spring to allow for displacement of the soles from one another but not total detachment of the soles from one another so as not to lose the bottom sole

Art Unit: 3728

when detached. With respect to the ligament being a strap, it appears that a strap, lace or any other stretchable or extendible connection means would work equally as well as the spring noted above.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ouellette et al. 5,644,857 as applied to claim 16 in paragraph 3 above. Ouellette et al. '857 as applied to claim 16 in paragraph 3 above discloses all the limitations of the claim except for the cleat including a shear pin extending upward through the upper and lower sole elements. Figure 12 of Ouellette et al. '857 gives the appearance that the shear pin 24 is aligned with and part of the cleat 18 and therefore teaches that the pin can be associated with the cleat with the pin extending through the upper and lower sole portions. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the shear pin part of the cleat, as alluded to in Figure 12 of Ouellette et al. '857, to allow for the shear pin to be easily replaced as the cleat is replaced.

Response to Arguments

9. Applicant's arguments filed July 3, 2006 have been fully considered but they are not persuasive. Applicants argues that nothing in Tecchio teaches or suggests a release mechanism that actuates upon exertion of a sheer force in a constrained direction. This argument is not persuasive because Tecchio continually senses all of the sheer forces being applied and sends this signal to the electronic control assembly. The electronic control assembly then may activate the release mechanism if the sheer force is higher than the predetermined sheer force. This meets the limitations of the claims because it does not limit the sheers forces to any one direction but includes sheer forces acting in any one specific direction. With respect to applicant's argument that nothing in Tecchio teaches or suggests any elements that would prevent lateral relative motion between the upper sole element and lower sole element, this argument is not persuasive because this limitation can clearly been seen by the positioning of 120 with respect to 140 in Tecchio in Figures 2 and 3. With regards to applicant's arguments that Ouellette does not teach

Art Unit: 3728

translation longitudinally or laterally, applicant notes that there may be a small amount of relative motion and therefore admits to the translation of motion (see applicant's arguments on page 6, last paragraph of Amendment filed July 3, 2006). Applicant further argues that the sole of Ouellette have nothing to do with releasable soles when a predetermined force is applied. This argument is not convincing because any sole would release at a predetermined force (i.e. the force at which the sole fails) and therefore this limitation is met by Ouellette. Applicant's arguments as to the "mischaracterization" of the portions of Ouellette are not convincing because the pins noted by the examiner would need to fail, i.e. shear, and would therefore be considered "shear pins" when they do fail. It appears that applicant is arguing more than that which is claimed. It appears applicant is arguing pins that shear at some predetermined number that applicant has failed to disclose or claim. Since there is no limitation on this "predetermined" number, the failing point of any pin would meet this "predetermined" number. Applicant further argues other limitations that they believe are mischaracterized by the examiner. These arguments are not persuasive because, as noted in the rejection, these portions of the prior art meet the limitations as claimed. With respect to applicant's argument that Starks does not teach break away pins, as argued previously, any pin has a predetermined force, i.e. point of failing, at which the pin would break. Applicant's further arguments towards the "break away" feature fails to take into consideration that all things break or have a failing point. Since the claims do not limit the force applied nor do the claim any particular predetermined force for break away to occur, the point at which the elements fail can be considered their "break away" point since the structure would fail at this point. Applicant's arguments with respect to the ligament portion in Tecchio are not persuasive. The only requirement of the claim is that the ligament prevent translation of the parts of the sole until a predetermined force is exerted. The spring of Tecchio does this at least until the time that the spring fails, and therefore meets this limitation of the claims. Applicant argues a specific type of structure for the ligament portion; however, this structure is not set forth in the claims and is therefore not a limitation of the invention.

Conclusion

10. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

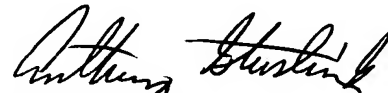
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

Art Unit: 3728

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS